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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,834	02/13/2002	Edward Raynes Eaton	TH1871Y	6354
23632	7590	09/27/2006		
SHELL OIL COMPANY P O BOX 2463 HOUSTON, TX 772522463				
			EXAMINER OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER

1751

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,834

Applicant(s)

EATON ET AL.

Examiner

Necholus Ogden

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Claims 1 and 3 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harman et al (2,725,359) is withdrawn.

Claims 1 and 3-6 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,818,146 is withdrawn in view of applicant's terminal disclaimer.

Election/Restrictions

Newly submitted claims 7-11 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: method of cooling a fuel cell engine is distinct from the composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-11 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fitzpatrick et al (4,617,490).

Fitzpatrick et al disclose a cathode ray tube device with improved color filtering system comprising 20 to 80% by weight of an alcohol such as 1,3 propanediol that not only act as a filtering medium but is an excellent coolant for the tube during operation while rendering the tube resistant to freezing during storage (col. 2, lines 20-37).

As this reference appears to teach all of the instantly required it is considered anticipatory.

In the alternative, Fitzpatrick et al is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Fitzpatrick to encompass the above mentioned characteristics because the compositions of Fitzpatrick et al specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as solution that has coolant and antifreeze properties. Therefore, the skilled artisan would have expected similar characteristics of the solutions disclosed in Fitzpatrick et al, in the absence of showing to the contrary.

1. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nambu (4,925,603).

Nambu discloses a gel cooling medium comprising an aqueous solution of polyvinyl alcohol and a water soluble organic compound or freezing point depressing agent such as 1,3 propylene glycol or 1,3 propanediol in an amount from 20 to 80% by weight (col. 9, lines 40-68 and col. 10, lines 15-16).

As this reference teaches all of the instantly required it is considered anticipatory.

In the alternative, Nambu is silent with respect to the electrical resistivity, boiling point, thermal conductivity, viscosity, heat capacity, and rejecting surface capacity. However, it would nonetheless been inherent to the compositions of Nambu to encompass the above-mentioned characteristics because the compositions of Nambu

Art Unit: 1751

specifically teach with sufficient specificity the specific 1,3 propanediol (trimethylene glycol) for the use as and additive in coolant compositions.

Response to Arguments

2. Applicant's arguments filed 7-16-2006 have been fully considered but they are not persuasive.

Applicant argues that Fitzpatrick et al do would not encompass the electrical resistivity as claimed because of additional components such as salts used in the light filtering solution.

The examiner contends that the heat rejecting surface capacity would be inherent to the 1,3 propanediol as suggested by applicant's specification and examples that only require 1,3 propanediol and water in their compositions. As Fitzpatrick et al teach 1,3 propanediol it would inherently meet that limitation. With respect to the additional components, required by Fitzpatrick et al, the examiner contends that applicants claimed composition is open to include additional components not required by the claims. For it is held that "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347; 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Applicant further argues that the viscosity of Nambu is silent, however because the composition is a gel it would not inherently comprise the current viscosity limitation.

Again, the examiner contends that applicant's claim is solely based on one component, 1,3 propanediol, wherein the claimed composition is open to include a plethora of material. Nambu is silent with respect to the viscosity it does comprise the 1, 3 propanediol components of the instant application in a coolant formulation. Therefore, it would have been inherent to the compositions of Nambu to expect the 1,3 propanediol component to comprise the properties as claimed given that Nambu requires the same component. Moreover it is held that in *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel."

Double Patenting

3. Claims 1 and 4-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/886,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in subject matter pertaining to coolant compositions with a 1,3 propanediol compound. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant argues that the double patenting rejection over 10/886,298 is improper because the instant application and copending application are not commonly owned.

The examiner contends and directs applications attention to MPEP 804, where it is stated that the application may have at least one common inventor and/or be commonly owned. Therefore, the rejection is maintained.

*Before consideration can be given to the issue of double patenting, two or more patents or applications >must have at least one common inventor **and/or** be either commonly assigned/owned or non-commonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3) pursuant to the CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)).*

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1751

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Necholus Ogden
Primary Examiner
Art Unit 1751

No
9-24-2006